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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,949	08/09/2001	Jan Zavada	D-0021.5C-1	9458
24988	7590	10/13/2006	EXAMINER	
LEONA L. LAUDER 235 MONTGOMERY STREET, SUITE 1026 SAN FRANCISCO, CA 94104-0332			YAEN, CHRISTOPHER H	
			ART UNIT	PAPER NUMBER
			1643	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,949

Applicant(s)

ZAVADA ET AL.

Examiner

Christopher H. Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-37,39,41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-37,39,41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Re: ZAVADA ET AL

1. The amendment filed 7/24/2006 is acknowledged and entered into the record. Accordingly, claims 1-30,38,40, and 43-44 are canceled without prejudice or disclaimer.
2. Claims 31-37,39, and 41-42 are pending and examined on the merits.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections Maintained - 35 USC § 112, 1st paragraph

4. The rejection of claims 31-37,39, and 41-42 under 35 USC § 112, 1st paragraph as lacking adequate written description is maintained for the reasons of record. Applicant argues that the amendment to replace the word "a" with "the" would cause "ambiguous antecedent". Specifically, applicant's indicate that the amendment to claims reflected by the addition of "the group consisting of" would render the claims adequately described. Applicant's arguments have been carefully considered but are not deemed persuasive to overcome the rejection of record.

The amendment to the claims do not overcome the written description rejection because the claimed "amino acid sequence" of the site still reads on a sequence as short as two amino acids derived from any of the claimed sequences listed in the Markush group. In other words, limiting the sequence by using Markush type language does not satisfy the lack of written description for a sequence of anything other than the sequence consisting of anyone of SEQ ID No: 10, 98-102, or 103.

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Again it is reiterated that applicant may overcome this rejection by amending the claims to indicate "the" sequence as opposed to "a sequence".

Therefore, the rejection of claims under 35 USC 112, 1st paragraph is maintained for the reasons of record.

NEW REJECTION

Claim Rejections - 35 USC § 112, 1st paragraph

5. Claims 31-37,39,41, and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. THIS IS A NEW MATTER REJECTION.

Applicant's have amended the claims to include a negative proviso limitation of "the non-MN-portion of said fusion protein or said fusion polypeptide does not contain a cell adhesion site". Applicant directs the examiner to page 21, lines 1-14 and page 69, lines 8-13 for support of this new limitation. However, the pages direct are drawn to the explanation of why the fusion protein would contain an additional binding site to which cells could potentially bind. There is no specific indication or disclosure that support a negative limitation or specific exclusion of fusion proteins missing a cell adhesion site as now currently claimed.

Applicant is invited to point to clear support or specific examples of the claimed invention in the specification as-filed, by specifically pointing to further support for the negative limitation currently claimed.

It is noted that the art rejections of record do not anticipate the claims as currently presented. However, if applicant reverts to the claims previously presented, wherein there is an exclusion of the negative limitation of no containing a cell adhesion site, the art rejection may be re-applied.

All other rejections are withdrawn in view of the applicant's amendments and arguments thereto as set forth in a paper filed 7/24/2006.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Yaen
Art Unit 1643
September 29, 2006


CHRISTOPHER H. YAEN
PRIMARY EXAMINER